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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,902	01/17/2002	Stephen M. Allen	BB-1163 US DIV	3372

23906 7590 08/26/2004

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WILMINGTON, DE 19805

EXAMINER

ROBINSON, HOPE A

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/051,902

Applicant(s)

ALLEN ET AL.

Examiner

Hope A. Robinson

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 16-31 is/are pending in the application.
- 4a) Of the above claim(s) 24-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2002 01/17
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Application Status***

1. Applicant's election without traverse of Group I (claims 16-24) on June 1, 2004 is acknowledged. Upon due reconsideration, applicant was notified that a further restriction was needed to remove claim 24 from Group I. A telephonic election was made without traverse on August 17, 2004 by applicant's representative Ms. Dawn Clark, thus Group I remains elected comprising claims 16-23.

2. The Amendments filed on June 1, 2004 have been received and entered in part. It is noted that applicant instructed the office to correct the sequence listing in the specification, however, applicant needs to submit a new sequence listing and computer readable form pursuant to 37 CFR 1.825(a) and the appropriate statement indicating that the two are the same.

### ***Change of Inventorship***

3. In view of the Petition filed on June 1, 2004, the inventorship in this application has been changed by the deletion of inventor Scott V. Tingey. Issuance of a corrected filing receipt reflecting the correction of inventorship will occur under a separate cover.

### ***Claim Disposition***

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4. Claims 1-15 have been canceled. Claims 16-19 have been amended. Claims 16-31 are pending. Claims 16-23 are under examination.

***Drawing***

5. The Drawings filed on May 20, 2002 are accepted by the Examiner.

***Information Disclosure Statement***

6. The Information Disclosure Statement filed on January 17, 2002 has been received and entered. The references cited on the PTO-1449 Form have been considered by the examiner and a copy is attached to the instant Office action.

***Specification***

7. The specification is objected to because of the following informalities:
- (a) The specification is objected to because trademarks are disclosed throughout the instant specification and not all of them are capitalized or accompanied by the generic terminology. The use of the trademarks such as Tris-HCL, for example, have been noted in this application (see page 27). It should be capitalized wherever it appears and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

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(b) The specification is also objected to because the Brief Description of the Drawings on page 2, only describes Figure 1 and does not mention parts A-E and only describes Figure 2 and parts A-D are not mentioned in the description.

(c) The title of the Invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following is suggested: "Nucleic Acid Encoding Plant Sugar Transport Proteins".

Correction is required.

### ***Claim Objection***

8. Claims 20-23 are objected to because of the following informalities:

Claims 20-23 are objected to because the claims have improper multiple dependent claims language. It is suggested that the claims are amended to recite "any one of claims 16 to 19".

### ***Claim Rejections - 35 USC 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claims 16-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 16-23 are directed to an isolated nucleic acid fragment comprising a nucleotide sequence that encodes a sugar transport protein. However, the claimed invention lacks adequate written description because on page 23 of the instant specification it is stated that the plasmid was deposited under the terms of the Budapest Treaty at ATCC, but there is no indication as to whether the deposited material is publicly available or can be reproducibly isolated. Without publicly available deposit information one of skill in the art could not be assured of the ability to practice the invention as claimed. Applicant's referral to the deposited material in the instant specification is noted but is considered insufficient assurance that all of the conditions of 37 CFR 1.801-1.809 have been met. If deposits have not been made under the Budapest Treaty, then in order to certify that the deposits meet the criteria set forth in 37 CFR 1.801-1.809, applicant may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that:

(A) During the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(B) All restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

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(C) The deposits will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;

(D) The deposits were viable at the time of deposit;

(E) The deposits will be replaced if they should ever become non-viable.

This requirement is necessary when a deposit is made under the provisions of the Budapest Treaty as the Treaty leaves these specific matters to the discretion of each member State. Amendment of the specification to disclose the date of the deposit and the complete name and address of the depository is required.

For further information concerning deposit practice, applicants attention is directed to In re Lundak 773 F 2d 1216 227 USPQ CAFC and 37 CFR 1.801-1.809.

Therefore, for all these reasons the specification lacks adequate written description, and one of skill in the art cannot reasonably conclude that the applicant had possession of the claimed invention at the time the instant application was filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter, which applicant (s) regard as their invention.

Claim 19 is indefinite for the recitation of "a nucleotide fragment corresponds to the nucleotide sequence set forth in SEQ ID NO:21" as it is unclear what corresponds to means in association with the claimed fragment, as "corresponds to" can be interpreted as equivalent or similar, thus the chemical structure is undefined.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hope A. Robinson whose telephone number is 571-272-0957. The examiner can normally be reached on Monday-Friday from 9:00 a.m. to 6:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon P. Weber, can be reached at (571) 272-0925.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



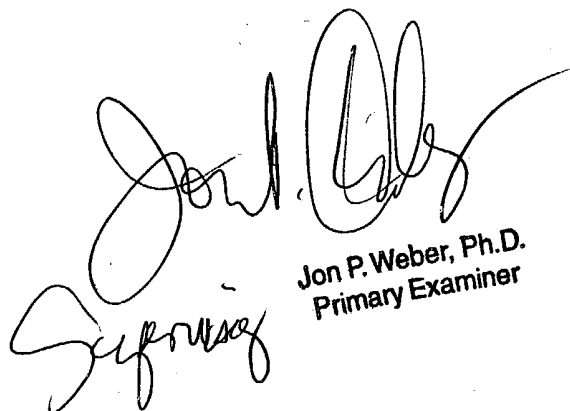
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Hope Robinson, MS ~~46~~<sup>462</sup>

Patent Examiner

A large, stylized handwritten signature in black ink, appearing to read 'Jon P. Weber'.

Jon P. Weber, Ph.D.  
Primary Examiner